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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/469,987	12/21/1999	MARK L. SKARPNESS	10559/094001	5632

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EXAMINER

NGUYEN, PHUONGCHAU BA

ART UNIT

PAPER NUMBER

2665

DATE MAILED: 08/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/469,987

Applicant(s)

SKARPNESS, MARK L.

Examiner

Phuongchau Ba Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11,13,14,16,18 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11,13,14,16,18 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Objections

1. Claim 18 is objected to because of the following informalities: "17" should be changed to ---16---. Appropriate correction is required.

Claim Rejections – 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 6 recites the limitation "said identifying numbers" in lines 8–9. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections – 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3–4 are rejected under 35 U.S.C. 102(e) as being anticipated by Pound (6,560,222).

Regarding claims 1, 3:

Pound discloses a modular communication system (fig.1), comprising:

a first communication device 12,

a first port 54 which allows receiving broadband information,

an expansion port 26 which provides output data to allow adding

additional data–receiving elements thereto, and

a first electronic element (not shown but included in the gateway for

selectively forwarding voice/data to a proper destination, e.g., phone 12 or

printer 22) which analyzes said broadband information and separates first voice

information intended for said first communication device 12, where said first

voice information is represented by a first communication identifying number

(telephone number of the telephone 12, claim 3) {fig.2}, from second voice information that is not intended for said first communication device (24), and couples said second voice information to said expansion port.

Regarding claim 4:

Pound further discloses wherein said first electronic element (not shown) produces an output in Ethernet format {col.6, lines 1-2}.

3. Claims 16, 18-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Gerszberg (6,510,152).

Regarding claim 16:

Gerszberg (6,510,152) discloses a method of providing service to a user (fig.5), comprising:

providing the user 15a with a first device (gateway 22) which provides a first level of service for data (via IEEE 1394 and COAX) and voice assigned to at least one first identifying number (via ISDN, tip/ring, Ethernet), said first device

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including an expansion capability (for transmitting data to plurality of devices, e.g., 14a-14b, 15a-15n, 18a-18n, 513-515); and

expanding the service to the user by allowing the expansion capability to be used for an additional service, said additional service including at least voice (analog telephone signals) that is not assigned to said at least one first identifying number (different telephone 15b, not shown in fig.5), said expanding comprising providing the user with an additionally expandable voice module (residential interface module 115) which allows a plurality of voice lines (15a-15n) to be obtained.

Regarding claim 18:

Gerszberg further comprises allowing further expansion by allowing additional voice lines (15b-15n, fig.5) to be obtained by providing the user with a second voice interface device (15b) which connects to first voice module (115, fig.5).

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Regarding claim 19:

Gerszberg further discloses wherein said expanding comprises determining information intended for said module 115 (as if voice data for voice terminals 15a-15n, fig.5) and sending all information (voice data for voice terminals 130, 14a-14b, 18a-18n, fig.5) not intended for said module (voice terminals 115) to said expansion capability (voice terminals 130, 14a-14b, 18a-18n, fig.5).

Claim Rejections – 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pound as applied to claim 1 above, and further in view of Yablon (5,764,731).

Regarding claims 6–7:

Pound does not explicitly disclose the claimed features. However, in the same field of endeavor, However, in the same field of endeavor, Yablon (5,764,731) further discloses a computer (fig.4) comprising a memory device (directory memory, fig.4) that stores numbers indicative of information intended for said voice adapter; a controller (computer, fig.4) which investigates information from said high bandwidth stream, and determines portions of said information which represent voice intended for numbers stored in said memory device {col.16, lines 10–30}. Therefore, it would have been obvious to apply Yablon's teaching to Pound's system with the motivation being to friendly user for obtaining a telephone number in a variety setting.

5. Claims 8–9, 13–14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edson (6,526,581) in view Yablon (5,764,731).

Regarding claim 8:

Edson (6,526,581) discloses device (gateway), comprising:

a connection (ADSL 15; fig.1) to a high bandwidth information stream;

A voice adapter (ADSL modem) receiving voice information;

A memory device (107, fig.2);

a controller (CPU);

a first output port 21 for said data; and

an expansion output port 23 part of for said voice.

Edson does not explicitly disclose that the memory device (107, fig.2) that stores numbers indicative of information intended for said voice adapter;

a controller (CPU 105) which investigates information from said high bandwidth stream, and determines portions of said information which represent voice intended for numbers stored in said memory device. However, in the same field of endeavor, Yablon (5,764,731) further discloses a computer (fig.4) comprising a memory device (directory memory, fig.4) that stores numbers indicative of information intended for said voice adapter; a controller (computer, fig.4) which investigates information from said high bandwidth stream, and determines portions of said information which represent voice intended for numbers stored in said memory device {col.16, lines 10-30}.

Therefore, it would have been obvious to apply Yablon's teaching to Edson's

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system with the motivation being to friendly user for obtaining a telephone number in a variety setting.

Regarding claim 9:

Edson further comprises a universal serial bus host 127, coupled to receive said other portions of said information (analog), and produce an output indicative thereof, at said port expansion output port 21.

Regarding claims 13–14:

Edson (6,526,581) further comprises wherein said voice adapter 312 includes a pulse code modulation adapter device (CODEC 57, col.14, lines 3–17) (claim 13), wherein said voice adapter has connectors (51&53, col.13, line 30) for at least one telephone 32 (claim 14).

6. Claims 10–11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edson (6,526,581) in view Yablon (5,764,731) as applied to claim 8 above, and further in view of Riemann (5,892,764).

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Regarding claim 10:

Edson does not explicitly disclose the claimed features. However, in the same field of endeavor, Riemann (5,892,764) further discloses wherein said controller (module control processor 58, fig.5) formats said data into a standard network format {col.9, lines 26-33, 58-col.10, line 23}. Therefore, it would have been obvious to an artisan to apply Riemann's teaching to Edson's system with the motivation being to provide communication between users in different networks having different protocol format.

Regarding claim 11:

Edson further discloses wherein said standard network format is a format from the group consisting of Ethernet, USB or HPNA {col.7, lines 64-67}.

5. Claims 2, 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pound in view Edson (6,526,581).

Regarding claims 2, 5:

Pound does not explicitly disclose the claimed features. However, in the same field of endeavor, Edson discloses a second communication device/universal serial bus adapter 312 (claims 5/2) for receiving said voice information. Therefore, it would have been obvious to an artisan to apply Edson's teaching of voice adapter 312 to coupled to said expansion output port 94 in Pound's system and the motivation being to emulate an analog type plain old telephone service (POTS) type line appearance to the telephone 32; to send and receive tone signals and analog speech communications; also to provide the necessary conversions between digital and analog and sends and receives data messages over the media 21 relating to the standard telephone line signaling used by the POTS telephone 32; and to provide a normal analog interface between the line 21 and the telephone device 32 and the logic to select between analog and digital communications {col.8, lines 12-31, Edson}.

Response to Arguments

7. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuongchau Ba Nguyen whose

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telephone number is 703-305-0093. The examiner can normally be reached on Monday-Friday from 10:00 a.m. to 3:00 p.m..

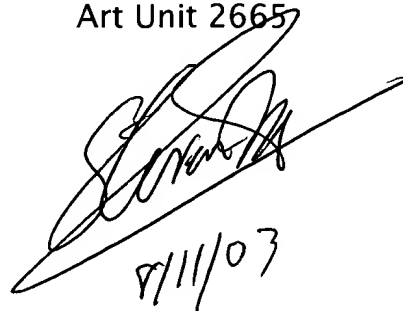
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on 703-308-6602. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.



Phuongchau Ba Nguyen
Examiner
Art Unit 2665

August 11, 2003


8/11/03